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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/519,283

07/26/2005

Keiji Urakami

37324

8915

116

7590

11/16/2005

PEARNE & GORDON LLP

1801 EAST 9TH STREET

SUITE 1200

CLEVELAND, OH 44114-3108

EXAMINER

KIM, AHSHIK

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/519,283		URAKAMI ET AL.	
	Examiner		Art Unit	
	Ahshik Kim		2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/27/04 (initial filing of application).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1/25/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

- 5 1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the
10 basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- 15 (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 2, and 4-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Moreau
20 et al. (US 6,874,685, hereinafter “Moreau”).

Re claims 1 and 8, Moreau discloses a settlement information notifying server/terminal 1 comprising a plurality of notifying units embodied as a display 7 and a loudspeaker 8 to inform the users, which receives a settlement of a smart card 3 (col. 4, lines 45+). The transport company manages the fair-collection system, which includes terminal and other network
25 infrastructure (col. 2, lines 55-63). The user, in paying the correct amount, is allowed to enter/exit a predetermined region (col. 3, lines 51-65).

Re claims 2, 4-6, and 9, the card contains an electronic credit for the purchase of the ticket (col. 1, lines 35-47; col. 2, lines 59+). When the balance is lower than a threshold amount,

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the user is invited to hand in the card (col. 3, lines 35-50). The ticket can be used to try to purchase ticket a multiple times. The presence of notification is initiated by the user.

Claim Rejections - 35 USC § 103

5 4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

10 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15 5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

20 6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jonstromer (US 6,142,369, hereinafter "Jonstromer") in view of Moreau et al. (US 6,874,685).

25 Jonstromer discloses electronic transaction terminal 4 for the users to conduct electronic transaction utilizing a smart card (see abstract) wherein the purchasing party transmits necessary information to the payee for the transaction (col. 1, lines 11+; col. 1, lines 47+). Once purchase is made, an electronic receipt is transmitted to the communication module of the terminal and eventually to the smart card (col. 1, lines 62-col. 2, line 20).

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Jonstromer fails to specifically teach or fairly suggest that the transaction is a kind that allows the purchaser to go through a predetermined region.

Moreau's teachings are mentioned in paragraph 3 above. Moreau discloses a smart card transaction system wherein the purchaser is allowed to go through the entrance with purchased
5 fare.

In view of Moreau's disclosure, it would have been obvious to an ordinary skill in the art at the time the invention was made to design the transaction system to include purchase of fair of the mass transportation system. Just as if the credit card is being used in virtually any embodiment where money is accepted, the smart card disclosed in Jonstromer can be used in
10 purchasing a transit ticket. Such modification would have been an obvious expedient, well within the ordinary skill in the art.

7. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moreau et al. (US 6,874,685) in view of Derksen (US 5,478,993, hereinafter "Derksen").

The teachings of Moreau have been discussed above. Moreau, however, fails to teach
15 that the method of issuing warnings when the total amount spent exceeds the threshold amount, or the spent amount is compared with a plurality of thresholds.

Derksen discloses a transaction card wherein the card is loaded with a plurality of threshold values – three sets of warning value and limiting values – in order to reduce unauthorized use of the transaction card (see abstract; col. 1, lines 23+; col. 1, lines 53+). The
20 three threshold values can be queried and change (col. 4, lines 51+) Three thresholds are used in staggered manner to avoid unauthorized use (col. 5 lines 4+).

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In view of Derksen's teachings, it would have been obvious to an ordinary skill in the art at the time the invention was made to further employ well known threshold to ensure that the card is used in responsible manner. The owner of the card should be aware of the current balance and the amount it can purchase. Granted that Moreau's card is "rechargeable" so that it can be replenished if it is short for a given transaction, incorporating such customer's friendly feature in terms of available balances and spent amount would be contemplated by one ordinary skill in the art.

Conclusion

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Hiroya et al. (US 5,754,654); Hirose (US 5,877,484); Piikivi (US 6,776,339); Takahira et al. (US 5,382,778); Hogan (US 5,557,516) discloses transaction/settlement cards. Applicant is respectfully suggested to carefully review these references.

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (571)272-2393. The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571)272-2398. The fax number directly to the Examiner is (571)273-2393. The fax phone number for this Group is (703)872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished application is available for Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions or access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



Ahshik Kim
Primary Examiner
Art Unit 2876
November 10, 2005